

REMARKS

I. Status of the Claims

Claims 1-71 are pending. Claims 60-71 are withdrawn as directed to non-elected subject matter. Without prejudice or disclaimer, Claims 23-24 and 26-27 have been amended. Exemplary support can be found in the specification and claims as filed. Accordingly, there is no written description issue.

Applicant respectfully acknowledges the Examiner's withdrawal of the rejection of claims 1-59 under 35 U.S.C. § 103 over the combination of U.S. Patent No. 4,927,627 (the '627 patent), U.S. Patent No. 6,645,476 (the '476 patent), and U.S. Patent No. 6,180,118 (the '118 patent) as moot in view of the current rejections. See Office Action at 3.

Applicant's undersigned representative wishes to thank the Examiner for her time in discussing the rejections under 35 U.S.C. § 112 on March 26, 2009.

II. Rejections under 35 U.S.C. § 112

The Examiner rejects claims 23-24 and 26-27 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite "for failing to point out and distinctly claim the subject matter which applicant regards as the invention." Office Action at 2.

Specifically, the Examiner indicates that the claims 23-24 lack antecedent basis with respect to the terms "cross-linked and non-crosslinked." *Id.* To advance prosecution, Applicants have amended claims 23-24 to depend from Claim 8, which contains reference to crosslinked and non-crosslinked polymers.

The Examiner also indicates that claims 26-27 lack antecedent basis with respect to "r." Applicant appreciates the Examiner pointing out this typographical error.

Applicant has amended claims 26-27 to recite "x" instead of "r." Therefore, Applicant believes the rejection of claims 26 and 27 under 35 U.S.C. § 112 to be moot and request that it be withdrawn.

III. Rejection under 35 U.S.C. § 103(a)

The Examiner rejects claims 1-59 under 35 U.S.C. § 103(a) as being allegedly "unpatentable over" the combination of WO 02/051,369 (WO '369)¹ and U.S. Patent No. 4,927,627 (the '627 patent) for the reasons set forth in the Office Action at pages 3-5.

Applicant respectfully traverses for the following reasons.

With respect to obviousness, several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; see also *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1730, 82 U.S.P.Q.2d 1385, 1388 (2007).

¹ The Examiner's states that "[t]he examiner is relying on English equivalent of WO document, which is PGPUB US 2004/0074015 ('015)." For convenience, Applicant's references to WO '369 will therefore also be to PGPUB US 2004/0074015 (the '015 application).

Indeed, to establish a *prima facie* case of obviousness, the examiner must:

make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. Knowledge of applicant’s disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences,” conduct the search and evaluate the “subject matter as a whole” of the invention.

M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). “The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” *Id.* It is important to note, moreover, that the prior art references relied upon in a rejection “must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention,” when such reasons are articulated by the Examiner. *Graham*, 383 U.S. at 17, 148 U.S.P.Q. at 467; *See also* M.P.E.P. § 2141.03(VI) (emphasis added).

Applicant respectfully submits that such reasons are not present in the rejection of record at least because the references relied upon by the Examiner, when considered as a whole, provide no reason that would have prompted a person of ordinary skill in the art to modify and combine the references in the manner suggested by the Examiner. In fact, for the reasons set forth below, Applicant submits that the references, when considered in their entirety, include portions that would discourage the modification and combination suggested by the Examiner.

Independent claim 1 requires “an oxidizing cream oil-in-water emulsion.” As acknowledged by the Examiner on page 4 of the Office Action, WO ‘369 fails to teach “oxidizing oil-in-water emulsion.” However, the Examiner alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of WO ‘369 to prepare it in the form of cream emulsion because

"it is easier to apply the bleaching compositions in the form cream instead of hydrous."

Office Action at 4.

Applicants respectfully disagree with this assertion because WO '369 teaches away from using any other formulation besides a transparent gel. In modifying WO '369, the Examiner alleges that a hydrous composition will be replaced by a cream, but WO '369 teaches transparent gels. In fact, WO '369 touts the superiority of transparent gels and notes that cosmetic formulations in the form of transparent gels have been sought for many years and are appreciated by consumers. WO '369 Specification [0015]. WO '369 discourages the use of other formulations and specifically teaches that "it has also been found that ready-to-use bleaching compositions containing the oxidizing agent(s) and also the thickening systems of the prior art do not allow a sufficiently precise application without the composition running or without reductions in viscosity over time." WO '369 Specification, [0011]. As stated in WO '369, the Applicant "discovered, surprisingly, a novel family of thickeners and/or gelling agents for obtaining transparent gels..." WO '369 Specification [0020] (emphasis added). Because WO '369 clearly limits itself to transparent gels, the disclosure of the WO '369 does not motivate, but actually leads away from the '672 patent, which teaches the use of a cream emulsion.

In view of the above arguments, Applicant submits that the Examiner has not established a prima facie case of obviousness. Thus, the rejection of claims 1-59 under 35 U.S.C. § 103(a) as being unpatentable over the combination of WO '369 and '627, is in error and should be withdrawn.

IV. Double Patenting Rejections

In the Office Action, the Examiner rejects claims 1-59 on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1-41 and 71-80 and 83 of U.S. Patent No. 7,338,534 (the '534 patent) in view of U.S. Patent 4,927,627 (the '627 patent). Office Action at 5-6. The Examiner also provisionally rejects claims 1-59 on the grounds of non-statutory obviousness-type double patenting as being unpatentable over co-pending Application No. 10/451,409 in view of U.S. Patent 4,927,627. Office Action at 6. Applicants presently agree with the double patenting rejections and plan to file an appropriate Terminal Disclaimer when allowable subject matter for the pending claims is indicated.

V. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and timely allowance of the pending claims.


If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is respectfully invited to contact Applicant's undersigned counsel at (202) 408-4443.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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